

REMARKS

Claims 11-23 are now in this Application, and are presented for the Examiner's consideration.

Rejection of Claims under 35 U.S.C. §112

Claims 1-23 were rejected under 35 U.S.C. §112, second paragraph, as being indefinite, on the basis that applicant appears to be claiming the ground.

In regard to the rejection of claims 1, 11 and 22, claim 1 has been canceled; and claims 11 and 22 have been amended to recite that the enclosed housing is adapted to be fixed to a ground surface, thereby making it clear that the ground does not form part of the claimed invention.

As to claim 8, this claim has been canceled. However, claim 19 which corresponds to claim 8, has been amended to change "inner shell" to --inner support-- in order to provide proper antecedent basis.

Accordingly, it is respectfully submitted that the rejection of claims 1-23 under 35 U.S.C. §112, second paragraph, has been overcome.

Prior Art Rejections

Claims 1 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 4,984,139 to Goggia.

Since claims 1 and 9 have been canceled, it is respectfully submitted that the rejection of claims 1 and 9 under 35 U.S.C. §102(b) has been rendered moot.

Claims 1-9 and 11-20 were rejected under 35 U.S.C. §103(a) as being obvious from U.S. Patent No. 4,974,134 to Bourne in view of U.S. Patent No. 3,856,092 to Mann.

Claims 1-9 have been canceled, and this rejection will therefore be discussed in relation to claims 11-20.

Claim 11, from which claims 12-20 depend, recites the combination of:

a) a raisable/retractable inner support which is adapted to hold electronic components, for example, stereo equipment, etc. outside; and

b) a precipitation sensor on the device for detecting precipitation and a control associated therewith to move the inner support to the retracted position when the sensor detects precipitation, in order to automatically protect the electronic components held by the inner support and which would be damaged if subjected to the precipitation.

Now, with respect to the references cited, Bourne was cited merely for disclosing a raisable pedestal with an enclosed housing 14 fixed to a ground surface, and having an inner support 12 mounted for movement between a retracted position entirely

within the housing and an extended position extending out from the housing. It was also cited for disclosing an arrangement 40 for supporting electronic components, a driving arrangement 48, 54, 56 for moving the inner support between the retracted and extended positions, and a control switch 112 connected with the driving arrangement to move the support between the positions. In addition, a spring arrangement 148 was cited as being positioned below the inner shell 32.

It was admitted that Bourne does not disclose a precipitation sensor, but Bourne was cited for disclosing a sensor connected to a control for controlling the driving arrangement to move the inner support to retracted and extended positions upon light detection. The Examiner states that, since water sensors for activating devices when precipitation is detected are well known in the art, it would have been obvious to one of ordinary skill in the art to have replaced the light sensor of Bourne with a water sensor to activate the control means using precipitation, rather than light, to protect it from water.

However, in Bourne, there is no protection of the light from the elements. In fact, this is not needed, since the bulb 40 is encased in a protective lens member having a transparent side wall 32 and opaque top wall 34. The most that Bourne shows is that the inner support 12 is raised only when there is little

light outside, regardless of the elements, such as rain, etc. Thus, for example, if a crack or leakage occurs in the protective lens member, the light will still be raised and exposed to the elements if there is little ambient light outside.

It is therefore submitted that the considerations for raising and lowering the inner support of Bourne have no relation to the outside elements, such as precipitation, and that one skilled in the art would not consider modifying Bourne to add a rain sensor.

This is further reinforced by the fact that the rain sensor patents deal primarily with activating or deactivating devices that have a definite functional relation to rain, rather than as a protection of the devices. For example, a windshield wiper is activated upon sensing rain, not as protection, but to ensure that the front window of the vehicle remains clear during driving. In like manner, when a sprinkler head is retracted during detection of rain, it is not to protect the sprinkler head, but rather, to prevent the waste of dispensing water when it is raining. In other words, there is no rain sensor patent which automatically protects components of the device in response to detection of precipitation.

Since Bourne does not function to protect any internal components, but rather, only to activate/deactivate the light in response to the lack of detection/detection of ambient light, the

light bulb has a functional relation to the ambient light. In like manner, since the rain sensor patents also do not protect any internal components, but rather, also only activate/deactivate an operational device (sprinkler head, windshield wiper, etc.) in response to the detection or lack of detection of rain, they also only provide a functional relation to the rain. Thus, there is no logical reason to incorporate a rain sensor into the Bourne device. This is because there is no device to activate or deactivate in response to the rain, such as a windshield wiper, sprinkler head, etc. In other words, there is no device in the present invention that has a functional relation with respect to the rain. Rather, the only concern with the present claimed invention is the protection of the electronic circuitry. There is no functional device that needs to be actuated as with a windshield wiper or sprinkler head. The only way to provide some logical reason to combine the references would be if there was an element in Bourne that had a functional relation to the rain.

Certainly, the electronic components held by the inner support of the present claimed invention do not perform any function with respect to the rain, as with a windshield wiper or sprinkler head. Rather, they only need to be protected. In Bourne and the rain sensor patents, there are active components that need to be activated/deactivated in response to external

conditions and which are functionally related to these external conditions. This is not the case with the present invention where there are no active components that need to be activated/deactivated. Rather, there are only passive components that need to be protected from the external elements.

As the Court of Customs and Patent Appeals has stated in In re Sponnoble, 160 U.S.P.Q. 237, 243 (CCPA 1969):

"A patentable invention may lie in the discovery of the source of a problem even though the remedy may be obvious once the source of the problem is identified. This is part of the 'subject matter as a whole' which should always be considered in determining the obviousness of an invention under 35 USC 103 (cases cited). The Court must be ever alert not to read obviousness into an invention on the basis of the applicant's own statement; that is we must view the prior art without reading into that art applicant's teaching (cases cited). The issue, then, is whether the teachings of the prior art, in and of themselves and without the benefit of applicant's disclosure, make the invention as a whole, obvious."

In this case, it is submitted that part of the invention is the discovery of the problem, that is, the protection of the passive components, which was not even remotely realized in Bourne or any of the rain sensor patents. Therefore, the problem of providing a protection system, let alone one with a retractable inner support for holding electronic components, and a precipitation sensor for use therewith, is not even discussed or remotely suggested, so that a solution to such problem would not be apparent, absent the teachings of the present application. In this regard, the determination of the problem forms part of

the present invention.

Further, "[m]odification unwarranted by the disclosure of a reference is improper." Carl Schenck, A G. v. Nortron Corporation, 218 U.S.P.Q. 698, 702 (C.A.F.C. 1983). In this case, Bourne does not seek to protect the light, but merely to activate it in accordance with the ambient light conditions. The same can be said as to the rain sensor patents.

An Examiner cannot arbitrarily pick and choose elements from the prior art in a piecemeal fashion to construct the claimed invention, without some direction from the prior art. In re Donovan and Ryan, 184 U.S.P.Q. 414, 420 (C.C.P.A. 1971). Thus, it is submitted that combining these references as suggested by the Examiner, could only result from impermissible hindsight utilizing applicant's own disclosure to construct the present invention from bits and pieces of the prior art. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 U.S.P.Q. 303, 312-313 (C.A.F.C. 1983); In re McLaughlin, 170 U.S.P.Q. 209 (C.C.P.A. 1971).

In order to emphasize this distinction, claim 11 has been amended to recite that the control which moves the inner support to the retracted position when the sensor detects precipitation, does so in order to protect the electronic components supported by the inner support from the precipitation. Thus, the protection aspect of the present invention has been emphasized,

which is very different from the Bourne light sensor and the rain sensor patents, which have functional components related to the external conditions, and which need to be activated/deactivated in response thereto.

In summary, there is no logical reason to incorporate a rain sensor in Bourne since there is no part of Bourne which needs to be activated in response to the rain, such as a windshield wiper, sprinkler head, etc. and no part of Bourne which needs to be protected from the external elements.

Mann was merely cited for disclosing a telescoping arrangement, and therefore, fails to cure any of the deficiencies regarding the rain sensor discussed above in regard to Bourne.

Accordingly, it is respectfully submitted that the rejection of claims 1-9 and 11-20 under 35 U.S.C. §103(a), has been overcome.

Claims 10 and 21-23 were rejected under 35 U.S.C. §103(a) as being obvious from Bourne in view of Mann, and further in view of Goggia.

Claim 10 has been canceled.

The remarks previously made above in regard to Bourne and Mann are incorporated herein. Thus, since claim 21 depends from claim 11, it is submitted that it is allowable for the same reasons give above in regard to claim 11.

Claim 22 has been amended in the same manner as claim 11, and it is submitted that claim 22, and claim 23 which depends therefrom, are allowable for the same reasons give above in regard to claim 11.

Goggia was merely cited for disclosing a piston driving arrangement, and therefore fails to cure any of the deficiencies regarding the rain sensor as a protective device, as discussed above in regard to Bourne.

Accordingly, it is respectfully submitted that the rejection of claims 10 and 21-23 under 35 U.S.C. §103(a), has been overcome.

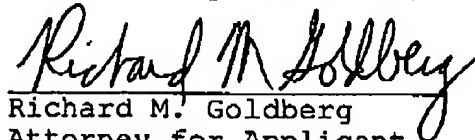
If the Examiner has any comments, questions, objections or recommendations, the Examiner is invited to telephone the undersigned at the telephone number given below for prompt action.

In the event that this Paper is late filed, and the necessary petition for extension of time is not filed concurrently herewith, please consider this as a Petition for the requisite extension of time, and to the extent not tendered by check attached hereto, authorization to charge the extension fee, or any other fee required in connection with this Paper, to Account No. 07-1524.

The Commissioner is authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 07-1524.

In view of the foregoing amendments and remarks, it is respectfully submitted that Claims 11-23 are allowable, and early and favorable consideration thereof is solicited.

Respectfully submitted,



Richard M. Goldberg
Attorney for Applicant
Registration No. 28,215

25 East Salem Street
Suite 419
Hackensack, New Jersey 07601
TEL (201) 343-7775
FAX (201) 488-3884
e-mail: goldbergpat@earthlink.net